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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,880	09/28/2001	John S. Hendricks	3960.D18	2103

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ANDREWS KURTH L.L.P.  
1701 PENNSYLVANIA AVENUE, N.W. SUITE 300  
WASHINGTON, DC 20006

EXAMINER
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VO, TUNG T

ART UNIT	PAPER NUMBER
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2613

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/964,880

Applicant(s)

HENDRICKS, JOHN S.

Examiner

TUNG T. VO

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 10-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>08/19/2002</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Priority*

1. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. However, the provisional application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 10-29 of this application.

Applicant has claimed priority from application 07/991,074 filed on 12/09/1992. However, applicant is not entitled to the priority of the cited application as he fails to provide adequate support for the claims in the present application filed on 11/07/1994. The new priority date for this application is from application 08/336,247.

### *Information Disclosure Statement*

2. The information disclosure statement (IDS) submitted on 08/19/2002 has been considered.

### *Specification*

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by *this invention*," "The disclosure describes," "*The invention*," etc.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 10-12, 20-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Chui et al. (US 5,604,824).

Re claims 10 and 20, Chui discloses an apparatus for carrying out a method for providing electronic books (a document from image source 8 of fig. 1, see also col. 6, lines 28-44) displayed on viewers (34d of fig. 1) comprising an operation center (22 and 26 of fig. 1) for communicating with viewers (34p and 34d of fig. 1) for providing electronic books, wherein the operations executes a method comprising:

receiving text material (8 of fig. 1) for a plurality of electronic books in a plurality of formats (“document”, col. 6, lines 28-44; “picture book” services, col. 8, lines 3-9);

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converting (12 of fig. 1) the text material in the plurality of formats to a standard format;  
storing (22 of fig. 1) the plurality of electronic books in the standard format (col. 8, lines 38- col. 9, line 6); and

selectively (34d or 34p of fig. 1) providing the electronic books to subscribers in the standard format via the viewers (30 of fig. 1).

Re claims 11 and 21, Chui further discloses wherein the receiving step includes receiving the electronic books in a plurality of digital formats (col. 7, lines 1-10).

Re claims 12 and 22, Chui further discloses wherein the converting step includes converting the text material into a standard compressed format (10 and 20 of fig. 1).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 14-19 and 24-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chui et al. (US 5,604,824) in view of Ross (US 5,465,213).

Re claims 14-19 and 24-29, Chui further teaches the network (26 of fig. 1) would communicate the viewer at the remote location, but Chui does not particularly teach the steps of grouping the text material by titles of the corresponding electronic books, permitting subscribers

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to purchase the electronic books via the viewers and portable viewers that includes a menu on viewers to provide indications of electronic books as claimed.

However, Ross teaches the steps of grouping the text material by titles of the corresponding electronic books (fig. 5), permitting subscribers to purchase the electronic books via the viewers (col. 7, lines 24-64); electronically communicating with portable viewers (costumer module (103 of fig. 3) is a self-contained assembly of electronic components and circuitry, as a stage in a computer, which would be made in a portable or handheld device as a design choice) for providing the electronic books (105 and 103 of fig. 3), displaying a menu on the viewers providing indications of the electronic books (col. 7, lines 24-64, e.g. displaying the menu, book titles, authors); generating a textual signal for providing the text material and a menu signal for providing the menu (col. 7, lines 35-46).

Taking the teachings of Chui and Ross as a whole, it would have been obvious to one of ordinary skill in the art to incorporate the teachings of Ross into the apparatus of Chui for the same purpose of purchasing the electronic books using the menu display on the portable module screen (103 of fig. 3) of Ross at the remote location.

Doing so would provide the electronic book system for everyone to easily purchase and hold a large inventory of books for a retail store or mail order catalogue concern, to reduce floor space requirements, to provide for reduction of the number of employees needed to run a retail book store, to provide for the reduction of shoplifting costs, employee pilferage costs, damage to inventory and dead inventory costs as well as shipping costs associated with the operation of a retail as suggested by Ross (col. 3).

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8. Claims 13 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chui et al. (US 5,604,824) in view of Grady et al. (US 5,528,281).

Re claims 13 and 23, Chui further teaches the step of converting the text into a compressed format but not a format according to the MPEG standard as claimed.

However, Grady teaches the step of converting the text into the digital format according to the MPEG standard (col. 5, lines 18-36).

Taking the teachings of Chui and Grady as a whole, it would have been obvious to one of ordinary skill in the art to incorporate the MPEG standard format of Grady into the compressor (20 of fig. 1) of Chui for same purpose of compressing the electronic (digital) books into the compressed electronic book accordance to the MPEG standard to save the memory storage. Doing so would improve the availability of electronic book service to the public.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Brindle et al. (US 5,526,469) discloses a system for printing image data in a versatile print server.


### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TUNG T. VO whose telephone number is 703-308-5874. The examiner can normally be reached on M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris. Kelley can be reached on 703-305-4856. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**TUNG T. VO**  
**PATENT EXAMINER**  
T.Vo

**TUNG T. VO**  
**Primary Examiner**  
**Art Unit 2613**